

Restriction Requirement

The Examiner has required restriction to one group of compounds. Applicant has elected the compounds of Group I, Claims 26, 28, 29 and 33. Applicant has canceled Claims 27, and 30-32 as being drawn to a non-elected invention.

Rejection of Claims under 35 U.S.C. § 103

The Examiner indicated in the Office Action mailed October 16, 1996, that Claims 28 and 29 would be allowable if rewritten in independent form. Applicant has amended independent Claim 25 to incorporate the language of Claims 28, 29 and 34 in accordance with the Examiner's suggestion. Therefore, Applicant respectfully submits that the rejections based on 35 U.S.C. § 103 are rendered moot. Applicant requests that the Examiner withdraw the rejection.

Rejection of Claims 25, 26, 34 and 36-40 under Obviousness-type Doubling Patenting

The Examiner has rejected Claims 25, 26, 34, and 36-40 under obviousness-type double patenting over claim 1 of U.S.S.N. 08/168,817. Claim 25 has been amended to specify administration of 3-aminothalidomide and 3-hydroxythalidomide, metabolites and hydrolysis of each, and mixtures thereof. Applicant's amendment of Claim 25 and cancellation of Claims 26 and 34 have rendered this rejection moot. Applicant requests that the Examiner withdraw the rejection.

Rejection of Claim 35 under Obviousness-type Doubling Patenting

The Examiner has rejected Claim 35 under obviousness-type double patenting over claims of U.S.S.N. 08/371,987. Applicant respectfully submits that U.S.S.N. 08/371,987 requires the presence of an epoxide hydrolase inhibitor, whereas the present invention does not. Applicant requests that the Examiner withdraw the rejection.

Rejection of Claim 34 under 35 U.S.C. § 112, second paragraph

The Examiner rejected Claim 34 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 34 has been canceled, and the language of this claim has been incorporated into Claim 25. Claim 25 is directed to the method of administering 3-aminothalidomide and 3-hydroxythalidomide. Applicant submits that claiming the metabolites and hydrolysis products of these two compounds, and mixtures thereof, does not render the claim vague or indefinite. Applicant requests that the Examiner withdraw the rejection.

Pursuant to 37 C.F.R. § 1.98(d), inasmuch as this application relies on prior applications Serial No. 08/168,817 filed December 15, 1993, and Serial No. 08/025,046 filed March 1, 1993, no copy of any patent, publication or other information previously cited by or submitted to the Office in such prior applications needs to be filed in the present application. The references requested in the Office Action mailed October 16, 1996, are such references. In order to facilitate prosecution, Applicant will submit the requested references.

In light of the amendments and the above remarks, Applicant is of the opinion that the Office Action has been completely responded to and that the application is now in condition for allowance. Such action is respectfully requested. If the Examiner believes any informalities remain in the application which may be corrected by Examiner's Amendment, or there are any other issues which can be resolved by telephone interview, a telephone call to the

undersigned attorney at (404) 818-3700 is respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Mary Anthony Merchant', with a long horizontal flourish extending to the right.

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